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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,693	03/20/2000	James Wright	00 P 7518 US	5947
7590	05/18/2004		EXAMINER FISCHER, ANDREW J	
Siemens Corporation Intellectual Property Department 186 Wood Avenue South Iselin, NJ 08830			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/528,693

Applicant(s)

WRIGHT ET AL.

Examiner

Andrew J. Fischer

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicants' amendment filed March 3, 2004 (Paper No. 19) is acknowledged.

Accordingly, claims 1-6 remain pending.

2. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

Claim Rejections - 35 USC §102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Cragun et. al. (U.S. 5,804,803) ("Cragun '803"). Cragun '803 discloses a product information apparatus comprising an indicator (radio frequency tag having code 117, translation program 110, and URL output; the bar code is a machine readable form of the URL) associated with a product and embedded in a memory (in the magnetic encoded with the radio frequency tag); a web page (document 174) indicated by the indicator (via the URL); the

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indicator directs the web page to product information (inherent) where the information is provided to the user (via display screen 114); wherein the indicator is specific to each product (tangible object 115) such that a plurality of indicators are needed to find out information about a plurality of products; the indicator (at least the bar code part) is disposed on the label which is on the object (tangible object 115 in Figure 1A); memory (106); means for automatically interfacing with the Internet to access the web page (120 and 121); and the memory is a micro-chip (inherent in radio frequency tag).

5. Claims 1-6, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(e) as being anticipated by Reber et. al. (U.S. 5,940,595)("Reber '595"). Reber '595 discloses a product information apparatus (80) comprising an indicator (the machine readable data within the RF device which is within 80) associated with a predetermined product with the indicator embedded in a memory (the information/indicator is within the memory which is in turn, within the RF tag); the product is coupleable to a PLC (the RF device contains a PLC since the RF device is an "active" RF device and the RF device is coupleable to the product); the PLC is coupleable to a network (the Internet); the indicator is indicative of a network webpage (inherent in URLs) where product information is provided; the network webpage having an online product help window (inherent in webpages); the indicator is specific to each product (there is only one indicator per product); and the memory is a micro-chip (inherent in an "active" radio frequency tag).

Claim Rejections - 35 USC §103

6. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all

obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, as understood by the Examiner, are alternatively rejected under 35 U.S.C.

§103(a) as being unpatentable over Cragun '803 in view of Ohanian et. al. (U.S. 6,109,526)

("Ohanian").¹ It is the Examiner principle position that the claims are anticipated because of the inherent features (*i.e.* the old and well known structure and features of RF tags). However if not inherent, Ohanian directly teaches the use of RF tags in replace of bar codes because, inter alia, bar codes may be obscured.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cragun '803 as taught by Ohanian to include RF tags in replace of bar codes. Such a modification would have helped get the data more quickly if the bar codes became obscured and would have allowed the tags to be reused because they electronically rewritten with data thereby overcoming the permanency of barcode symbols.

8. Claims 1-6, as understood by the Examiner, are also alternatively rejected under 35

U.S.C. §103(a) as being unpatentable over Hudz et. al. (U.S. 5,978,773)("Hudz") in view of

Ohanian. Hudz directly or inherently discloses all the claimed features except it uses bar codes

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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instead of memory. Ohanian directly teaches the use of RF tags (a PLC) in replace of bar codes because, inter alia, bar codes may be obscured.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hudz as taught by Ohanian to include RF tags in replace of bar codes. Such a modification would have helped get the data more quickly if the bar codes became obscured.

9. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustom meanings. To support this position, the Examiner again notes the following factual findings as first expounded in the previous Office Actions.² First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements.³ Third, after receiving express notice of the Examiner's position that lexicography is *not*

²See the Examiner's Initial Office Action mailed January 6, 2003, Paper No. 9, Paragraph No. 18; and the First Final Office Action mailed July 30, 2003, Paper No. 14, Paragraph No. 18; and the Office Action mailed December 17, 2003, Paper No. 18, Paragraph No. 14.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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invoked,⁴ Applicants first response did not point out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants’ intent, the Examiner also notes that Applicants have declined the Examiner’s express invitation⁵ to be their own lexicographer.⁶ Finally, after receiving express notice of the preceding factual findings and conclusions, Applicants’ latest response again fails to point out the supposed errors in the Examiner’s position regarding *lexicography invocation* in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants’ latest response—while again fully considered by the Examiner—does not change the Examiner’s conclusion that Applicants have decided not to be their own lexicographer. Therefore (and except for the invocation of 112 6th paragraph noted below), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their “broadest reasonable interpretation,” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997),⁷ and the Examiner continues to rely heavily and extensively on this interpretation.⁸

⁴ See the Examiner’s Initial Office Action mailed January 6, 2003, Paper No. 9, Paragraph No. 18.

⁵ *Id.*

⁶ The Examiner’s requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner’s requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed May 17, 2004).

⁷ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim

35 U.S.C. 112 6th Paragraph**Means Phrase #1*****Invocation***

It is the Examiner's position that in claim 6, the phrase "means for automatically interfacing to an internet to access said web page based on said indicator" ("Means Phrase #1") is an attempt by Applicants to invoke 35 U.S.C. 112 6th paragraph. If Applicants disagree, the Examiner respectfully requests Applicants to either amend the claim to remove all instances of "means for" from the claim, or to explicitly state on the record (and supply arguments in support thereof) why 35 U.S.C. 112 6th paragraph should not be invoked.

Invocation Step 1:

First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th* ("Guidelines")⁹, and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),¹⁰ Applicant's use of "means for" in claim 1 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112

language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification."); MPEP §§2111 and 2111.01; and *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: "he examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

⁹ Federal Register Vol 65, No 120, June 21, 2000.

¹⁰ See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

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6th paragraph. If the word “means” appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which §112 6th paragraph applies. *Id.* Since “means for” is recited in Means Phrase #1, this step is clearly met.

Invocation - Step 2:

Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the Examiner’s position that Applicants recite a corresponding function to the means—“automatically interfacing to an internet to access said web page based on said indicator.”

The Examiner notes that when determining the function recited “[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language.” *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). In this case, because nothing suggests otherwise, the function as found in the Means Phrase #1 will have its ordinary meaning.

Invocation - Step 3:

Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

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In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, "the focus remains on whether the claim ... recites sufficiently definite structure." *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). Clearly the "automatically interfacing to the internet" can not be entirely performed by the little if any recited structure in the claim.

Because of the above, it is the Examiner's position that Means Phrase #1 invokes 35 U.S.C. 112 6th paragraph.

Corresponding Structure, Material, or Acts

In accordance with MPEP §2181, the Guidelines (section "II") and *Medtronic*, 248 F.3d at 1311, 58 USPQ2d at 1614, "The next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim." *Id.*

In this case, the corresponding structure is Internet interface 20

Furthermore, it is the Examiner's position that the means-plus-function limitation in claim 6 is not the claim's *only* point of novelty. First, the pending system claims are combination claims made of old and possibly new elements. See *e.g. Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446, 54 USPQ2d 1185, 1190 (Fed. Cir. 2000)(noting that there is "a general rule that combination claims can consist of combinations of old elements as well as new elements"). Second, in combination claims, there is no essential element or "gist" of the invention. *Cooper Cameron Corp. v. Kvaerner Oilfield Products Inc.*, 62 USPQ2d 1846, 1850 (Fed. Cir. 2002) (noting that "there is no legally recognizable or protected 'essential' element, 'gist' or 'heart' of the invention in a combination patent."). In light of these facts and after further review of the specification, the Examiner finds that the means-plus-function limitation is not solely determinative of patentability. In other words, the Examiner finds that the means-plus-function limitation in the claim 6 is not the *only* point of novelty. The Examiner relies on this presumption.

Response to Arguments

10. Applicants' arguments filed March 3, 2004 (Paper No. 19) have been fully considered but they are not persuasive.

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Williams's Declaration

11. The Examiner has reviewed the declaration of Dr. Ronald D. Williams filed under 37 C.F.R. §1.132 and a part of Paper No. 19 filed on March 3, 2004 ("Williams Declaration") but finds the declaration insufficient to overcome the current rejections of record.

12. The Williams Declaration does not address the scope of claim interpretation during ex parte examination. Although the Williams Declaration states the Examiner's definition is incorrect, the Williams Declaration fails to state *why* the Examiner's definitions are not proper in this context. Moreover, not only does the Williams Declaration fail to provide objective evidence as to why the Examiner's definitions are improper, the Williams Declaration fails to provide evidence as to why Dr. William's definitions should be controlling.

Other Arguments

13. In this case, it appears the main issue is Applicants' and the Examiner disagreement over how the term "programmable logic controller" should be interpreted. The Examiner maintains his position that such element(s) are disclosed in the references noted above.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

17. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a

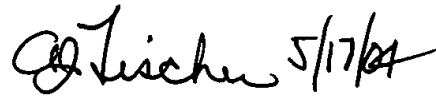
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claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

18. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their “Remarks” (Paper No. 19 beginning on page 4) traversing the Examiner’s positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹¹ the Examiner respectfully reminds Applicants to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner’s positions or have other questions regarding this communication or even previous

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communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Patent Examiner
Art Unit 3627

AJF
May 17, 2004

11 *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.